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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/776,502

02/12/2004

Leopoldo Alarcon

60282.00112

3668

32294

7590

11/28/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

GONZALEZ, AMANCIO

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

11/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,502

Applicant(s)

ALARCON ET AL.

Examiner

AMANCIO GONZALEZ

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 41-54 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-23 and 41-54 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments filed on 07/23/2008 have been fully considered, not found persuasive.

Regarding the applicant's argument that the combination of Bhagwat and Gregorio fails to teach or suggest every recited limitation of claims 1, 3-23, 41, and 43-54, as stated in page 14 of 23 of the remarks filed in the response to the Office Action dated March 26, 2008, the examiner asserts that the aforesaid prior art references address and disclose the main subject matter of the present application invention as stated in the independent claims.

Considering claims independent claims 1 and 14, sending a message including information for identifying a first network access entity from a mobile entity to a second network access entity, wherein the message is configured to enable a connection of the mobile entity to be handed over from the first network access entity to the second network access entity, and wherein the message is configured to enable the second network entity to direct traffic destined to the first network entity would have clearly identified by a person of ordinary skill in the art at the time the invention was made as the handoff of a call or data connection for a mobile node roaming between two different communication networks. Bhagwat discloses a handoff for a roaming mobile node (col. 9 lines 43-50, col. 14 lines 10-13).

Gregorio further discloses wherein, in the process of servicing a visiting user equipment UE, the AAA of the visited network, V-AAA, accesses a global directory and communicates afterwards with the UE home AAA, H-AAA in order to complete the

connection to the roaming UE, which a person of ordinary skill in the art at the time the invention was made would have unequivocally interpreted as the claimed limitation wherein a global address of a first network access entity is not known to the mobile entity first network access entity is not known to the mobile entity. Gregorio teaches wherein (see Gregorio: fig. 2).

Therefore the cited references read in the argued features as applied to claims 1-23 in the previous Office Action, also shown below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 49 and 50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 49 and 50 are directed to a computer program for which no reference is made in the specification associating said computer program with any method, system, or apparatus claimed in the invention. The claims also lack proper preamble for a computer readable medium claim and.

An example of an acceptable preamble for a computer type claims is "A computer readable medium encoded with computer executable instructions, the instructions comprising". For further information on statutory computer type claims, see MPEP section 2100.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 41, and 43-54** are rejected under 35 U.S.C. 102(b) as being anticipated by **Kennedy, III et al. (6,018,657)**.

Consider **claim 41**, Kennedy, III et al. clearly show and disclose an apparatus, comprising: a processor (gateway MSC [fig. 4, col. 10 lines 15-26]) wherein the processor is configured to process data related to sending a message including information to identify a first network access entity to a second network access entity (Originating external device **18** communicates local message to a gateway MSC coupled to originating external device; if the gateway MSC does not service destination messaging unit, the gateway MSC retrieves an identifier for the next MSC of destination messaging unit **14** from its database **34** [col. 10 lines 28-46]), which enables the second network access entity to direct traffic to the first network access entity, wherein a global address of the first network access entity is not known to the apparatus (communication system **10** communicates any number of remote messages to reach the serving MSC of destination messaging unit; when remote message reaches the serving MSC of destination messaging unit, the serving MSC generates local message for delivery to destination messaging unit; [col. 9 lines 29-49, col. 10 lines 44-61]).

Consider **claim 45**, Kennedy, III et al. clearly show and disclose an apparatus, comprising: a processor (serving MSC [fig. 5, col. 11 lines 7-27]) configured to process data related to sending a message including information to identify a second network access entity to a first network access entity, (Originating messaging unit **14** then communicates local message to the serving MSC; Internal message formats address messaging units **14** using a mobile identification number (MIN), or any other suitable address or identifier of messaging units; if the serving MSC is not the gateway MSC coupled to destination external device then the serving MSC consults its database to retrieve the address of the next MSC to generate remote message [col. 9 lines 29-49, col. 11 lines 10-25]), which enables the first network access entity to direct traffic to the second network access entity, wherein a global address of the second network access entity is not known to the apparatus (serving MSC communicates remote message to the next MSC along the communication path to external device; determining if the next MSC is the gateway MSC, and if not, generating and communicating remote message until remote message arrives at the gateway MSC coupled to destination external device [col. 20-25]).

Consider **claim 53**, Kennedy, III et al. clearly show and disclose an apparatus, comprising: forming means for forming a message including information for identifying a second network access entity to a first network access entity, (Originating messaging unit **14** then communicates local message).

Claims 49-51, 52, and 54 as amended address the same subject matter as claims 41, 45, and 53, therefore same rejection applies.

Consider claims 43-47 as amended. Kennedy teaches claims 41 and 45, and further discloses cellular registrations, call processing, and hand-off procedures (see col. 1 line 12-31).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1 and 3-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhagwat et al. (US 6651105 B1), hereafter "Bhagwat," in view of de Gregorio et al. (US 20070127495 A1), hereafter "Gregorio."

Consider claim 1 as amended, Bhagwat discloses sending a message including information for identifying a first network access entity from a mobile entity to a second network access entity, wherein the message is configured to enable a connection of the mobile entity to be handed over from the first network access entity to the second network access entity, and wherein the message is configured to enable the second

network entity to direct traffic destined to the first network entity (**see col. 8 lines 65-67, col. 9 lines 1-5, col. 10 lines 43-47**), but does not particularly refer to wherein a global address of the first network access entity is not known to the mobile entity. Gregorio teaches wherein a global address of the first network access entity is not known to the mobile entity (**see par. 0077**).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Bhagwat and have it include wherein a global address of the first network access entity is not known to the mobile entity, as taught by Gregorio, thereby providing means for the motivation of implementing Single Sign-On services for of users accessing a service network via Internet through a packet radio network, as discussed by Gregorio (**see par. 0001**).

Consider claims 2, 3, 19, and 20, Bhagwat as modified by Gregorio teaches claims 1 and 14 respectively, and Gregorio further teaches checking whether the address is globally routable (see Gregorio: par. 0077).

Consider claims 5-7, Bhagwat as modified by Gregorio teaches claims 1 and 14 respectively, and Bhagwat further teaches sending the message before establishing connection between the mobile entity and the first network access entity (see col. 8 lines 65-67, col. 9 lines 1-5).

Consider claims 8 and 22. Bhagwat as modified by Gregorio teaches claims 1 and 14 respectively, and Gregorio further teaches IP address mapping (see Gregorio: par. 0082).

Consider claim 9. Bhagwat as modified by Gregorio teaches claims 1 and 14 respectively, and Bhagwat further teaches an old network identity associated with the first network access entity (see Bhagwat: col. 10 lines 43-47).

Consider claims 10, 11, 13, 15, 16, and 18. Bhagwat as modified by Gregorio teaches claims 1 and 14 respectively, and Bhagwat further teaches proxy related functions (see Bhagwat: col. 5 lines 12-25).

Consider claim 21. Bhagwat as modified by Gregorio teaches claims 1 and 14 respectively, and Bhagwat further teaches handover functions (see Bhagwat: col. 3 lines 36-40, fig. 8).

Consider claims 12, 17, and 23. Bhagwat as modified by Gregorio teaches claims 1 and 14 respectively, and Bhagwat further teaches identification functions (see Bhagwat: the abstract, col. 11 lines 34-37).

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claims 1, 3-23, 41, and 43-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhagwat et al. (US 6651105 B1), hereafter "Bhagwat," in view of de Gregorio et al. (US 20070127495 A1), hereafter "Gregorio," as applied to claims 1 and 41 respectively, further in view of Takusagawa et al. (US 20030225892 A1), hereafter "Takusagawa."

Consider claim 2. Bhagwat as modified by Gregorio teaches claims 1 and 41 respectively, but does not particularly refer to fast binding update. Takusagawa teaches fast binding update (see pars. 0110, 0111, and 0114).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Bhagwat as modified by Gregorio and have it include fast binding update, as taught by Takusagawa, thereby providing means for the motivation avoiding packet loss during a fast handoff in a mobile communication system, as discussed by Takusagawa (see pars. 0042-0048).

8. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kennedy, III et al. (6,018,657)**, hereafter "Kennedy," as applied to claim 41, further in view of Takusagawa et al. (US 20030225892 A1), hereafter "Takusagawa."

Consider claim 42 as amended. Kennedy teaches claim 41, but does not particularly refer to fast binding update. Takusagawa teaches fast binding update (see pars. 0110, 0111, and 0114).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Kennedy and have it include fast binding update, as taught by Takusagawa, thereby providing means for the motivation avoiding packet loss during a fast handoff in a mobile communication system, as discussed by Takusagawa (see pars. 0042-0048).

Response to Arguments

Applicant's arguments with respect to claims 41-54, have been also considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Delaney Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amancio Gonzalez, whose telephone number is (571) 270-1106. The Examiner can normally be reached on Monday-Thursday from 8:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Appiah, can be reached at (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

AG/ag

November 24, 2008

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617